



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of:

Yun LING, et al.

Serial No.: 10/054,083

Group Art Unit: 2841

Filed: January 18, 2002

Examiner: D. Levi

FOR: A NOVEL LEVER DESIGN THAT COMBINES MODULE
INSERTION, RETENTION, EJECTION FUNCTIONS FOR
ADD-IN CARDS

REPLY BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Pursuant to 37 C.F.R. § 41.41, Applicant submits this reply brief, in response to the Examiner's Answer mailed February 25, 2005.

All arguments in Applicants' Appeal Brief, filed January 21, 2005, are herein incorporated into this Reply Brief.

In numbered paragraph 7, the Examiner erroneously refers to Grouping of Claims. Applicants note that the grouping of claims was eliminated in the final rule change made effective September 13, 2004. The cited rule 37 C.F.R. 1.192 has been removed and replaced with Section 41.37. There is no longer any requirement to group claims. The claims have been argued separately and do not stand or fall together as asserted by the Examiner.

In numbered paragraph 11, the Examiner purports to respond to applicants' arguments, but does so only selectively. The Examiner is required to answer all traversals and should

respond to the substance of all of applicants' arguments. The Board should consider that the Examiner has conceded all of applicants' arguments which have not been addressed or rebutted by the Examiner.

The Examiner's Answer only purports to respond to applicants' arguments on pages 3-5, 8, and 10 of the appeal brief. In fact, the Examiner's Answer fails to address the substance of the arguments on pages on 8 and 10. In any event, the Examiner does not rebut and appears to concede the substance of at least pages 6-7 and 9 of the appeal brief.

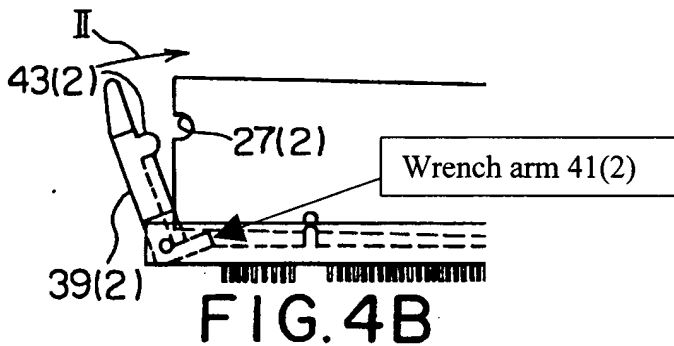
In particular, the Examiner has not rebutted and apparently concedes applicants' arguments on page 6 that Suzuki fails to teach or suggest that the side projection 43(2) applies a lever force on the recess 27(2) during insertion of the card board 21 into the connector 31. The Examiner has not rebutted and apparently concedes applicants' further arguments on page 6 that the side projection 43(2) in Suzuki provides only a retention function. Applicants note that the Examiner's response to applicants' arguments is devoid of any mention of the projection 43(2) or the recess 27(2). The Examiner relies on a generalized reading of the Suzuki reference instead of a detailed analysis of what the reference actually teaches.

The Examiner has also not rebutted and apparently concedes applicants' arguments on page 7 that the side projections 43 described by Suzuki do not provide an insertion function. The Examiner has not rebutted and apparently concedes applicants further arguments on page 7 that the first lever 39(1) described by Suzuki assists in the card insertion (albeit with a different structure and in a different manner from the present claims) while the second lever 39(2) described by Suzuki assists in the ejection.

Regarding the substance of the Examiner's analysis in connection with claim 1, the Examiner initially argues that "[o]ne of ordinary skill in the art in the art, given the teachings of Tondreault and Suzuki would have contemplated that a lever force is applied by the lever mechanism during insertion of the card in the slot of the connector." However, the examples given by the Examiner describe a lever force being applied by the card on the lever to make the lever rotate (see Examiner's answer, page 11, lines 14-16 and page 11, line 21 – page 12, line 2).

For example, in connection with Tondreault the Examiner argues “as the card is pushed down into the slot, the edge of the card bears on the lever and makes it rotate.” In connection with Suzuki, the Examiner argues “the edge of the lever contacts (i.e. touches) the card. This is why the lever can be rotated as a result of insertion of the card.”

It appears that in conceding applicants’ arguments, the Examiner has now changed positions. While the rejection of record clearly relies on the projection 43(2) for the recited engaging surface (see Examiner’s answer at page 5, lines 1-2 and 9, lines 14-17), the Examiner now appears to be relying on the wrench arm 41(2) for the recited engaging surface. For example, the Examiner argues that “the card 21 engages the engaging surface of lever mechanism 39(2), [refer to Fig. 4B].” The relevant cropped and annotated portion of Fig. 4B is reproduced below (annotated with the arrow pointing to the arm 41(2)):



As is readily apparent from the above figure, the card 21 engages only the wrench arm 41(2) of the lever mechanism 39(2), not the projection 43(2). Accordingly, it appears that the Examiner is now relying on the arm 41(2) for the recited engaging surface.

Applicants agree that Tondreault and Suzuki both teach that when the user pushes the card into the slot, the ejector 22 (in Tondreault) and the lever 39(2) are rotated into place. However this is irrelevant to the claims. What the Examiner has described and is now arguing is that the card applies a lever force on the lever mechanism during insertion of the card. This is precisely opposite to what is recited in the claims.

On page 12 of the Examiner's answer, the Examiner continues to misconstrue the phrase 'adapted to.' In the Examiner's view the phrase means capable of being so adapted. This is incorrect. Many materials and structures are capable of being adapted to have many forms and perform many functions. It is irrelevant whether or not the reference describes a material or structure which, given the hindsight benefit of the present disclosure, is capable of being changed into something that might read on the claims. The proper test is whether or not the reference describes the claim recitations. Claim 1 recites 'the engaging surface is adapted to contact a contact surface on the card' (emphasis added). Claim 1 does not recite 'the engaging surface may be adapted to' or 'the engaging surface is capable of being adapted to.' Accordingly, the claim recites clear and definite structure and function which is entitled to patentable weight and proper claim construction.

On page 13, the Examiner argues that the cited passage at col. 3, lines 47-57 is clear and unambiguous. As further evidence that the cited passage is in unclear broken English, applicants note that the Examiner has substantially misquoted the passage in the Examiner's answer. The Examiner's quote and the correct citation follow:

From page 12, line 22 – page 13, line 2 of the Examiner's Answer: "The first and second levers 39 are for prying in cooperation with the card 21 to put the card 21 into and out of mechanical contact with the card edge connector and to bring the connecting pads 25 into and out of electrical contact with the conductive contacts 17."

The actual citation, corrected with underlines for insertions and ~~striketrough~~ for deletions from the misquoted passage, reads as follows: "The first and the second levers 39 are for prying in cooperation ~~with~~ the card board 21 to put the card board 21 into and out of mechanical contact with the card edge connector 31 and to bring the connecting pads 25 into and out of the electrical ~~contact~~ connection with the conductive contacts 17.

Applicants do not point out the foregoing to embarrass the Examiner, but rather to point out the awkwardness of the cited passage. In any event, the cited passage is ambiguous regardless of the grammatical problems. The cited passages describes that the first and second

levers are involved with putting the card in and out of the slot. In different contexts this could mean, among other things, that both levers are used in both operations or it could mean that the first lever is used for the first operation and the second lever is used for the second operation. In the context of Suzuki, it is clear that this second context is the correct one as all other portions of Suzuki describe that the first lever 39(1) is used during insertion and the second lever 39(2) is used during ejection.

With respect to claims 11 and 13, the Examiner misconstrues applicants' arguments. Applicants do not argue that the prior art does not sufficiently designate the particular part relied upon. Rather, applicants argue that the Examiner does not sufficiently designate the particular part of the reference relied upon for disclosing each claim recitation and the interrelationships between the claim elements. The Examiner has the initial burden of coming forth with sufficient evidence, analysis, and arguments to establish a prima facie case of obviousness. It is very difficult and a strained exercise for applicants to rebut and / or overcome a rejection which has never been articulated by the Examiner. For example, applicants are entitled to come forward with rebuttal evidence to overcome an obviousness rejection. But without knowing the Examiner's precise positions, applicants are unable to determine what type of evidence might be appropriate. Although applicants submit that the Board should reverse the Examiner for the substantive reasons set forth in the appeal brief, at a minimum the Board should remand the case and require the Examiner to articulate a proper § 103 rejection for claims 11 and 13.

The Examiner indicates that he considers applicants' arguments in connection with claims 11 and 13 to be a repeat of applicants' earlier arguments. This is incorrect. For example, claim 11 is directed to performing various operations. Whether or not the structural limitations are met, the method may be separately patentable. Applicants arguments in connection with the method claims are directed to the failure of the references to teach or suggest the recited operations. To the extent the Examiner has not addressed or rebutted the substance of applicants' arguments on pages 8-9, the Board should consider that the Examiner has conceded the same.

Applicants note that the Examiner now appears to admit that the card insertion in both Tondreault and Suzuki is accomplished by the user pushing the card into the slot and not by actuating the levers. In other words, the Examiner's response admits that the references describe that the card moves the lever, and not vice versa.

Finally, applicants note that the Examiner's rejection of the claim 1 relies heavily on an improper construction of the phrase 'adapted to,' which is not present in the method claims. In order to establish a prima case of obviousness with respect to claims 11 and 13, the Examiner simply cannot rely on the same rejection as the apparatus claims. In other words, to read on the method claims it is not sufficient that the reference describe a structure that is 'capable' of doing something, the reference must actually teach or suggest performing the recitations of the method claims.

With respect to claim 14, the Examiner misconstrues applicants' arguments. Applicants do not argue that the prior art does not sufficiently designate the particular part relied upon. Rather, applicants argue that the Examiner does not sufficiently designate the particular part of the reference relied upon for disclosing each claim recitation and the interrelationships between the claim elements. The Examiner has the initial burden of coming forth with sufficient evidence, analysis, and arguments to establish a prima facie case of obviousness. It is very difficult and a strained exercise for applicants to rebut and / or overcome a rejection which has not been fully articulated by the Examiner. Although applicants submit that the Board should reverse the Examiner for the substantive reasons set forth in the appeal brief, at a minimum the Board should remand the case and require the Examiner to articulate a proper § 103 rejection for claim 14.

The Examiner indicates that he considers applicants' arguments in connection with claims 14 to be a repeat of applicants' earlier arguments. This is incorrect. For example, claim 14 includes different recitations which are separately argued. Also, claim 14 does not include the 'adapted to' language which is integral the Examiner's reasoning in connection with the preceding apparatus claims. To the extent the Examiner has not addressed or rebutted the

substance of applicants' arguments on pages 10, the Board should consider that the Examiner has conceded the same.

In view of the foregoing, together with Applicants' Appeal Brief, favorable reconsideration and reversal of the rejection is respectfully requested. Early notification of the same is earnestly solicited. If there are any questions regarding the present application, the Examiner and / or the Board is invited to contact the undersigned attorney at the telephone number listed below.

Respectfully submitted,

s/Paul E. Steiner/

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April 20, 2005

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I hereby certify that this correspondence is being deposited with the United States Postal service as first class mail with sufficient postage in an envelope addressed to:
Commissioner for Patents, P.O. Box 1450 Alexandria, VA 22313-1450

On: April 20, 2005

Signature

Rachael Brown
Rachael Brown

4/20/05
Date